REMARKS

1. Claim Rejections - 35 U.S.C. §112, first paragraph – Claims 8 and 46

Claims 8 and 46 are pending in the present application and were rejected in the Office Action dated November 4, 2004 under 35 U.S.C. § 112, first paragraph, as requiring clarification. Applicants respectfully traverse this rejection. Claims 8 and 46 are independent claims. However, in order to provide clarification, claims 8 and 46 have been amended.

The Examiner states that the specification provides enablement for the terms "stand-alone" and "remote," but that the Examiner is unclear how a "stand-alone" device can be remotely reconfigured. The Examiner further states that she believes that a "stand-alone" device, by definition, does not require support from another device or system, such as a network. As such, the Examiner has requested clarification. Claim 8 recites, "A stand-alone gaming machine, wherein the gaming machine locally contains a plurality of different games of chance, and wherein the gaming machine is connected to a network, but does not download games of chance via the network in response to a player request, the gaming machine comprising: one or more screens that display video content for a game of chance located on the stand-alone gaming machine, wherein all of the video content for a different game of chance is used to reconfigure the gaming machine in response to a reconfiguration command from a remote location."

The Examiner is correct insofar as the invention of independent claims 8 and 46 does not require support from another device or system in order to function, i.e., all of the video content for a plurality of games is stored locally on a stand-alone gaming machine. However, Applicants submit that this recitation does not prohibit any interaction whatsoever between the gaming machine and a network and/or other non-local (i.e., remote) components. This network may be utilized for transmitting gaming support information including, by way of example only, accounting/auditing information, player tracking information, ticket-printing information, game meter information, and the like. Accordingly, in the invention of claims 8 and 46: (1) the gaming machine locally contains a plurality of different games of chance, (2) the gaming machine is connected to a network but does not download games of chance via the network in response to a player request, and (3) the

video content for a different game of chance is used to reconfigure the gaming machine in response to a reconfiguration command from a remote location.

Accordingly, Applicant respectfully submits that the 35 U.S.C. § 112, first paragraph, rejection of claims 8 and 46 has been overcome.

2. Claim Rejections – 35 U.S.C. §103(a) – Claims 1-20, 30-46, 48-50, and 57-59

Claims 1-20, 30-46, 48-50, and 57-59 are pending in the present application and stand rejected in the Office Action dated November 4, 2004, under 35 U.S.C. § 103(a) as being unpatentable over Hedrick (USPN 6,135, 884) in view of Giobbi (USPN 6,749,510), and further in view of Marnell (USPN 5,393,057). Applicants respectfully traverse this rejection. However, in order to provide clarification only, claims 1, 8-11, 13, 14, and 46 have been amended. Claims 1, 8, and 46 are independent claims. Claims 9-11, 13, and 14 depend from independent claim 8. For brevity, only the bases for the rejection of the independent claims are traversed in detail on the understanding that dependent claims are also patentably distinct over the cited references as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate, and independent bases for patentability.

The Examiner states, "Hedrick further discloses [that] his gaming machine [is] capable of being easily modified/reconfigured with new games or features, 2:62-66." However, review of the citation given by the Examiner reveals that this language came from the Background of the Invention section. Hedrick merely proposes that "[i]n view of the above observations, it would be desirable to provide a gaming machine allowing the potential of **secondary game events** to be realized such that the machine can be easily modified with new games or features that can maintain or increase a player's interest or desire to play a particular game." (emphasis added). Secondary game events are defined in the Background of the Invention section as "information about slot tournaments, progressive games, bonusing schemes, and other incentives for maintaining a player's interest or to play in a particular manner." (emphasis added). [1:40-45]

The remainder of the Background of the Invention section discusses how this secondary game information previously was silk screened onto a gaming machine and the difficulties that such a process presented if the secondary game information needed to be changed. The Hedrick patent then discloses having this secondary game information presented on a secondary display screen. The secondary game information is typically stored on an EPROM memory chip in the gaming machine. Accordingly, the only way that this secondary game information can be modified is to (1) turn off the gaming machine, (2) open the gaming machine cabinet, (3) remove the EPROM from the gaming machine, (4) re-burn the EPROM with the new information, (5) re-install the EPROM in the gaming machine, and (6) turn on the gaming machine. This is clearly not an "easy reconfiguration process" and cannot be performed automatically and/or in response to a reconfiguration command or trigger, as required by the claimed invention.

Moreover, the Hedrick reference is directed towards the presentation of secondary game information on a secondary display screen (instead of the prior technique of silk screening). This is in stark contrast to the claimed invention that is directed towards the reconfiguration of an entire game from a first game into a second game, wherein the content for both games is locally stored in the gaming machine.

Referring now to the Giobbi reference, the Examiner states, "Giobbi teaches a gaming system in which video content is capable of being reconfigured in response to various triggers." However, the Giobbi reference teaches away from the claimed invention, in that it discloses a gaming system in which a game is executed on a game execution server and then transmitted via a network connection to a dumb terminal that merely displays the game activity that is being executed on the remote game execution server. In an alternate embodiment of the Giobbi invention, a game is downloaded, in response to a player request, from a master game server to a requesting remote display terminal where the game is locally executed by the terminal. Indeed, the claimed invention overcomes several disadvantages of the Giobbi invention. Specifically, by storing a plurality of games locally on the gaming machine many network associated problems are overcome, such as network breakdowns, network clogging and latency, network bandwidth limitations, and the like. In this manner, the claimed invention increases responsiveness and

minimizes network utilization. This is an important factor in gaming operations, where thousands of slot machines may be networked (which run close to 24 hours a day, 365 days a year) and want to appear immediately responsive to player demands. Thus, the Giobbi reference does not teach or suggest each and every element of the claimed invention. Neither does the Giobbi reference satisfy the shortcomings of the Hedrick reference.

Referring now to the Marnell reference, Applicants contend that the Marnell reference is non-analogous art. As such, Applicants are uncertain as to why it has been cited by the Examiner. The only relevance that the Marnell reference appears to have to the claimed invention is the use of the words "stand-alone." The Marnell reference has nothing to do with the "reconfigurability" of a gaming machine. In contrast, the Marnell reference relates to an electronic gaming apparatus that couples an electronic primary gaming device to an electronic secondary gaming device. Once again, this is in stark contrast to the claimed invention that is directed towards the reconfiguration of an entire game in a gaming machine from a first game into a second game, wherein the content for both games is locally stored in the gaming machine.

In conclusion, none of the cited references, either alone or in combination, teach or suggest each and every element of the claimed invention. Specifically, none of the cited references teach or suggest: (1) the gaming machine locally containing a plurality of different games of chance, and (2) the gaming machine connected to a network, but not downloading games of chance via the network in response to a player request. Furthermore, none of the cited references teach or suggest that the video content for a different game of chance is used to reconfigure the gaming machine in response to a reconfiguration command from a remote location. Accordingly, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection of claims 1-20, 30-46, 48-50, and 57-59 has been overcome.

3. Telephonic Interview of December 1, 2004

Applicants' representative and the Examiner conducted a telephonic interview on December 1, 2004, regarding the outstanding Office Action. During this telephonic interview

the Applicants' representative informed the Examiner that one or more pages were missing from the Office Action. The Examiner directed Applicants to retrieve the missing page(s) using PAIR. Additionally, the Applicants' representative explained why the Examiner's 35 U.S.C. § 112, first paragraph, rejection was inappropriate, since the use of the terms "stand-alone" and "remote" are not mutually exclusive as used in claims 8 and 46.

Moreover, Applicants' representative discussed the 35 U.S.C. § 103(a) rejection with the Examiner in reference to the cited references and the general state of the art not of record. Applicants' representative pointed out that none of the cited references (or art not of record) disclose a gaming machine that locally stores a plurality of games of chance (i.e., does not download games of chance via the network in response to a player request), and entirely reconfigures the gaming machine from a first game of chance to a second game of chance, in response to a reconfiguration command or trigger. This claimed invention was distinguished from the simple updating or modifying of a pay table or other mere secondary component of a game. Applicants' representative agreed to file a written response to the Office Action.

CONCLUSION

Applicants have made an earnest and bona fide effort to clarify the issues before the Examiner and to place this case in condition for allowance. In view of the foregoing discussions, it is clear that the differences between the claimed invention and the cited references are such that the claimed invention is patentably distinct over the cited references. Therefore, reconsideration and allowance of all of Applicants' claims 1-20, 30-46, 48-50, and 57-59 is believed to be in order, and an early Notice of Allowance to this effect is respectfully requested. If the Examiner should have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8319. The undersigned attorney can normally be reached Monday through Friday from about 9:30 AM to 6:30 PM Pacific Time.

Respectfully submitted,

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